

REMARKS

Status of the Claims

Claims 2, 3, 10 and 11 are canceled without prejudice to the subsequent filing of a continuing application. Claims 1, 9 and 15 are amended for reasons relating to patentability. Claims 1, 4-9, and 12-38 are pending in this case, of which claims 1, 9, 15, 20, 26, 32, and 36 are independent claims.

Prosecution History

The prosecution history is important for most patents, because it normally contains contemporaneous exchanges between the patent applicant and the Patent Office about what the claims mean. The prosecution history is thus a guide for teaching and clarifying what the claims mean and, more particularly, what the claim terms mean, because claim terms drive the meaning of claims. The meaning of claim terms must be given not only their structural meaning, but also their functional meaning. In this vein, an Examiner is not permitted to dissect a claim and remove the functional limitations before determining anticipation. Moreover, functional limitations in claims must be afforded patentable weight by the Examiner for determining anticipation.¹

A. 35 U.S.C. 102(b)

1. Denby et al. (US Patent 5,875,662)

¹See, e.g., *In re Ludtke*, 441 F.2d 660, 169 USPQ 563, 566 (C.C.P.A. 1971); *In re Atwood*, 354 F.2d 365, 148 USPQ 203, 210 (C.C.P.A. 1966); *In re Bisley*, 197 F.2d 355, 94 USPQ 80, 83 (C.C.P.A. 1952).

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Claims 1-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by Denby et al. (US Patent 5,875,662).

Independent claims 1, 9 and 15 set forth various embodiments of apparatus, which incorporate a handle having a key, a piston having a bore, and a cam disposed in the bore and having a keyway, a protuberance carried by one of the key and the cam at the keyway, a detachably engageable recess carried by the other of the key and the cam, and an attached spring acting on the protuberance biasing it one of a) away from the key, and b) into the keyway.

In Denby et al., examiner asserts that element 54a in FIG. 9 is applicant's claimed protuberance, as set forth in independent claims 1, 9, and 15 of this present application, and that this protuberance 54a is biased into the key by a user. In accordance with applicant's specification of the instant application, the claimed protuberance is added to the already existing key or to the already existing cam. The claimed protuberance can be carried by the key or by the cam, but the claimed protuberance is an additional structural feature, which is added to the already existing cam or the already existing key. It is clear that the prior art, namely, Denby et al., teaches a handle 54 having a key 54a that is receivable in keyhole 78. The key embodiments of Denby et al. teach of various key configurations, which are notched as desired.

In accordance with the invention set forth by applicant in the instant application, the contribution to the art is the provision of additional structural features, namely, a protuberance carried by one of the key and the

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cam at the keyway, a detachably engageable recess carried by the other of the key and the cam, and an attached spring acting on the protuberance biasing it one of a)away from the key, and b)into the keyway. This structure is absent in Denby et al. and secures the handle in place preventing its key from detaching from the keyway. A prior art key may be notched so as to provided a keyed engagement with a corresponding keyhole or keyway. However, this is not applicant's invention. In independent claims 1, 9 and 15, applicant indeed claims a key and a keyway. A novel aspect of applicant's invention, which is not taught or reasonably suggested in Denby et al., are the added provisions of a protuberance carried by one of the key and the cam at the keyway, a detachably engageable recess carried by the other of the key and the cam, and an attached spring acting on the protuberance biasing it one of a)away from the key, and b)into the keyway. Denby et al. fails to teach of providing its key and keyway with these additional structural features. Furthermore, although examiner states that protuberance 54a is biased into the key by a user, Denby et al. fails to teach of applicant's claimed protuberance and also the claimed provision of an attached spring acting on the protuberance biasing it one of a)away from the key, and b)into the keyway.

Accordingly, Denby et al. falls well short of teachings claimed by applicant in independent claims 1, 9, and 15. Based on the foregoing, the section 102 rejections of claims 1-19 as being anticipated by Denby et al. are believed moot and should be withdrawn.

B. 35 U.S.C. 103(a)

1. Denby et al. (US Patent 5,878,662), Brown (US Patent 2,720,804)

Claims 20-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Denby et al. (US Patent 5,878,662) in view of Brown (US Patent 2,720,804).

In applicant's independent claims 20, 26, 32 and 36, claimed are various embodiments of apparatus, which incorporate a handle having a key, a piston having a bore, and a cam disposed in the bore and having a keyway, and a magnetic attraction/engagement between the cam and the key. Examiner asserts that Brown teaches a magnetic attraction/engagement between a recess on one element and a key/tool, and that it would have been obvious to provide a key and cam of Denby et al. with a magnetic attraction/engagement between the two elements as taught by Brown in order to better retain the two elements in engagement.

In accordance with standard Patent Office practice, the Examiner has the burden of establishing a prima facie case of obviousness. (Manual of Patent Examining Procedure, M.P.E.P. 2142). Three basic criteria must be met to establish a prima facie case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or the references when combined) must teach or suggest all the claim limitations.

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According to the U.S. Court of Appeals for the Federal Circuit, "[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference. . . . Rather, we look to see whether combined teachings render the claimed subject matter obvious."² Also, "[o]bviousness cannot be established by combining the teachings of the prior art to produced the claimed invention, absent some teaching suggestion or incentive supporting the combination."³

An invention does not make itself obvious; that suggestion or teaching must come from the prior art. Examiner's conclusion that that it would have been obvious to provide a key and cam of Denby et al. with a magnetic attraction/engagement between the two elements as taught by Brown in order to better retain the two elements in engagement does not come from Denby et al. or from Brown. There is no teaching or suggestion in Denby et al. of the desirability of incorporating magnetic attraction/engagement between its key and cam. There is no teaching or suggestion in Brown of the desirability of incorporating a magnetic attraction/engagement between a key and cam of an assembly consisting of a handle having the key, a piston having a bore, and the cam disposed in the bore and having a keyway, as claimed by applicant. Accordingly, it is not proper to combine the teachings of

²*In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (C.C.P.A. 1979) (emphasis added) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 U.S.P.Q. 545, 549-50 (C.C.P.A. 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (C.C.P.A. 1964)).

³ See *In re Geiger*, 815 F.2d 686, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).

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Denby et al. with those of Brown. At most, Brown teaches magnetic engagement between two elements. However, just because magnetic engagement is known does not make it obvious in every application, and certainly does not make it obvious in connection with applicant's claimed invention without some teaching or motivation in the art explaining the desirability of providing a magnetic attraction/engagement between applicant's claimed key and cam.

There is no teaching in Denby et al. and/or Brown of the desirability to combine Brown with Denby et al. Accordingly, the combination is improper. If there is a teaching or suggestion to combine the teachings of Denby et al. with Brown, it comes from applicants' patent application and not from the prior art. Furthermore, assuming **arguendo** that even the combination of Denby et al. and Brown is proper, there is no teaching in either reference of where to incorporate a magnetic attraction. That teaching comes only from applicant's specification.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."⁴ Although the Examiner has identified, in the prior art, a quick release assembly in Denby et al. and magnetic attraction/engagement in Brown, the Examiner has not identified a teaching or suggestion in the prior art to combine these elements as claimed and set forth by applicants in independent claim 1.

⁴ Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 119 F.3d

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Furthermore, although Examiner states that it would have been obvious to provide a key and cam of Denby et al. with a magnetic attraction/engagement between the two elements as taught by Brown in order to better retain the two elements in engagement, Examiner has failed to identify such a teaching or suggestion in the prior art, namely, Denby et al. and/or Brown, and appears to be working from personal knowledge in making this statement. Applicant respectfully traverses Examiner's reasoning and respectfully request an affidavit from Examiner.

Accordingly, Examiner's section 103 rejections of claims 20-38 are believed moot and should be withdrawn.

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CONCLUSION

Applicant's claim terms mean something entirely different from the prior art of record in this case. In view of the foregoing going, applicant believes that all of the claims presently pending in this case are in condition for allowance, which action is earnestly solicited.

Examiner's thorough and thoughtful consideration of this application is sincerely appreciated. Should there be any remaining issues, Examiner is cordially invited to telephone the undersigned for a speedy resolution.

Respectfully submitted,



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